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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SCHWARTZ, DARREN B

ART UNIT

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2435

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,118	Applicant(s) BORDES ET AL.	
	Examiner DARREN SCHWARTZ	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant amends claim 1.

Claims 1-3 and 5 are re-presented for examination.

Response to Arguments

1. In light of the amendments to the claims, the Examiner withdraws the claim objection.
2. Applicant argues on page 4 of Remarks: "It is clear that the teaching of Saito (in view of Mason) at best discloses that any charges that would be incurred by a user would be performed right after the request for purchasing a program would be received at the 'charging center' in Saito. This is in contrast to the present invention where a bill i[s] drawn up where the 'duration of telephone communication is determined in said call center to draw up a bill corresponding to the reception of the program by the user terminal."

While Saito is clearly directed to the payment of CATV content (col 1, lines 57-64), a charging center which collects these fees for protected content (col 2, lines 17-21) and the actual payment of fees (col 3, lines 18-21 & lines 43-47), Saito does not "explicitly" teach "drawing up a bill;" while the Examiner believes one of ordinary skill would recognize that payment of cable television (e.g. CATV) corresponds to a bill created by the charging center or cable provider themselves, the Examiner introduces Korpela (U.S. Pat 6311054 B1).

3. Applicant argues on page 5 of Remarks: "Saito fails to disclose 'transmitting in sequence from said call center and during the telephone communication the keys to the user terminal over said telephone communication, said keys are used for descrambling said audiovisual program, where said telephone transmission of said keys is performed in a manner synchronized with the distribution of the successive encrypted portions of the program.'"

It is noted the Examiner applies Mason for said respective teachings (page 4 of the prior Office Action).

4. Applicant argues on page 6 of Remarks: "Therefore, if Saito discloses one communication path for TV signals and one communication path for key[s], these 2 distinct communications paths are contrary to Mason teachings."

In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Since Applicant merely argues the teachings of Saito are contrary to the teachings of Mason without any underlying facts to support such a conclusion, these statements are considered as argumentative. The arguments of counsel cannot take

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the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

5. Applicant argues on page 6 of Remarks, "Indeed in view of Mason, it is non obvious to disclose that [']a telephone transmission of keys is performed in a manner synchronized with the distribution of the successive encrypted portions of the program' as recited in claim 1."

The Examiner disagrees. First, Mason explicitly states "transmit[ting] the keys synchronously with the television signal" (column 7, lines 8-10). Secondly, one of ordinary skill recognizes in the art of streaming scrambled data, the data is typically descrambled linearly, in real-time. Since broadcasting CATV is linearly distributed, the encoding is linearly executed. Ergo, the keys are distributed in nearly a linear fashion to allow fast decoding and are thus synchronized to one-another.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito (U.S. Pat 5504933 A), hereinafter referred to as Saito, in view of Mason (U.S.

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Pat 4736422 A), hereinafter referred to as Mason, in further view of Korpela (U.S. Pat 6311054 B1), hereinafter referred to as Korpela.

Re claim 1: Saito teaches a method of distributing encrypted portions of an audiovisual program to user terminals comprising, successive portions of the program are encrypted with the aid of different keys, wherein, on initiation, from a user terminal, of a telephone communication with a call center (Figs 2 & 3), comprising the steps of:

transmitting said encrypted portions of an audiovisual program using at least one of: cable transmission, satellite transmission and over the airwaves transmission (Figs 2 & 3, see at least elts: "TV PROGRAM BROADCASTING STATION," "RADIO WAVE OR CABLE" & "RECEIVING DEVICE (TUNER/DECODER);" col 2, lines 29-55; col 3, lines 57-60);

a telephone communication is over a telephone path, which is separate from said at least one of cable transmission, satellite transmission and over the airwaves transmission (Figs 2 & 3, see at least elts: "CHARGING CENTER," "PUBLIC TELEPHONE LINE" & "DATA COMMUNICATION DEVICE;" col 3, lines 22-29; col 4, lines 21-33); and

Saito does not expressly disclose transmitting in sequence from said call center and during the telephone communication the keys to the user terminal over said telephone communication, said keys are used for descrambling said audiovisual program, where said telephone transmission of said keys is performed in a manner synchronized with the distribution of the successive encrypted portions of the program.

However, Mason teaches transmitting in sequence from said call center and during the telephone communication the keys to the user terminal over said telephone communication (Figure 1; col 2, lines 26-37), said keys are used for descrambling said audiovisual program (col 3, lines 37-42), where said telephone transmission of said keys is performed in a manner synchronized with the distribution of the successive encrypted portions of the program (col 7, lines 1-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Saito with the teachings of Mason, for the purpose of further securing the distributed content of Saito with the altering of the ciphering key thereby further securing the distributed of television or protected content.

While Saito is clearly directed to the payment of CATV content (col 1, lines 57-64), a charging center which collects these fees for protected content (col 2, lines 17-21) and the actual payment of fees (col 3, lines 18-21 & lines 43-47), the combination of Saito and Mason do not explicitly teach:

upon completion of the telephone communication with a user terminal, duration of telephone communication is determined in said call center as to draw up a bill corresponding to the reception of the program by the user terminal.

However, Korpela teaches upon completion of the telephone communication with a user terminal (col 1, lines 61-62; Figure 1, particularly element 5), duration of telephone communication is determined in said call center (col 3, lines 19-38) as to

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draw up a bill corresponding to the reception of the program by the user terminal (col 1, lines 10-15; col 1, lines 31-37; col 7, lines 34-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Saito and Mason with the teachings of Korpela, for the purpose of providing a user with a human readable invoice as to their consumed resources; in the instant case, distributed content over a network. Using a bill, be it digital or paper, provides the known benefit of allowing a customer to review their usage, defer & negotiate payment and increase QoS between the customer and payment center by providing personalized correspondence.

Re claim 2: The combination of Saito, Mason and Korpela teaches all the limitations of claim 1, but the combination does not expressly disclose the telephone communication utilizes an Internet protocol. However, it would have been obvious to one of ordinary skill at the time the invention was conceived to utilize an Internet protocol over a telephone network as an Internet protocol is part of a finite number of identified, predictable solutions to communicating over a telephone network. Further, there would have been a reasonable expectation of success as it is known that modems utilize various Internet protocols over a telephone network (*KSR International Co. v. Teleflex Inc., et al.* 550 U.S. 398, 127 S. Ct. 1727, 82 USPQ2d 1395, 1397 (2007))

Re claim 3: The combination of Saito, Mason and Korpela teaches synchronizing time codes are transmitted with the keys to the user terminal (Mason: col 7, lines 1-8).

Re claim 5: The combination of Saito, Mason and Korpela teaches the call center is a center for receiving telephone calls of a telephone operator (Saito: col 3, lines 15-18).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 7am-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./

Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435